UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/060,501	01/30/2002	Dennis W. Janes	85939.000217	8924

23387 7590 11/29/2002

Stephen B. Salai, Esq.
Harter, Secrest & Emery LLP
1600 Bausch & Lomb Place
Rochester, NY 14604-2711

EXAMINER	
PAULRAJ, CHRISTOPHER	
ART UNIT	PAPER NUMBER
1773	3

DATE MAILED: 11/29/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

A53

Office Action Summary	Application No.	Applicant(s)	
	10/060,501	JANES ET AL.	
	Examiner	Art Unit	
	Christopher G. Paulraj	1773	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *37-72 (as renumbered)* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *37-72 (as renumbered)* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

1. The preliminary amendment filed on January 30, 2002 has been entered. Claims 37-72 are pending. The claims filed with the amendment skipped the number 68. Therefore claims 69-73 were accordingly renumbered 68-72. The following action refers to the renumbered claims.

Furthermore, the preliminary amendment to the specification does not specify what type of priority the present application claims to the parent application 09/338,094. The amendment must indicate that the present application is a divisional of the parent application, as indicated on the file wrapper. The status of the parent application must also be updated to indicate that it has matured into U.S. Patent 6,406,785.

Double Patenting

2. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

3. Claims 37, 39, 42-45, 47-50, 52-54, 56-60, 62-68, and 70-72 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-30 of prior U.S. Patent No. 6,406,785. This is a double patenting rejection. The claims appear to be exact duplicates of the claims of the parent application.

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 38, 40, 46, and 55 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 2, 4, 6, and 9, respectively, of U.S. Patent No. 6,406,785. Although the conflicting claims are not identical, they are not patentably distinct from each other because one skilled in the art would have found it obvious to crosslink the “cross linkable” urethane recited in claim 2 of the ‘785 Patent. The motivation for doing so would have been to improve the strength and cohesiveness of the claimed weatherseal. One skilled in the art would have also found it obvious to form projections from the UHMW polyolefin particles recited in claim 4 of the ‘785 Patent. The motivation for doing so would have been to optimize the friction properties of the weatherseal. One skilled in the art would have also found it obvious to adjust the melting temperature of the thermoplastic particles recited in claims 6 and 9 of the ‘785 Patent to above the curing temperature of the thermoset carrier. The motivation for doing so would have been to retain the integrity of the particles after the formation of the weatherseal.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 41, 51, 52, 61, and 69 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification, as originally filed, does not disclose that Applicants possessed the concept that the olefinic particles themselves are crosslinked or that the olefinic particles are sufficiently bonded to the cured thermoset based carrier to substantially preclude *non-destructive* separation. The preliminary amendment is not considered as part of the originally filed specification.

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 39, 40, 41, 48, 52, 58, and 66 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

10. Claims 39, 40, 48, 58, 66 recite an alternative limitation using improper Markush group terminology. Alternative expressions are permitted if they present no uncertainty or ambiguity with respect to the question of scope or clarity of the claims. One

acceptable form of alternative expression, which is commonly referred to as a Markush group, is recited as "wherein R is a material selected from the group consisting of A, B, C and D." See Ex parte Markush, 1925 C.D. 126 (Comm'r Pat. 1925). It is improper to use the term "comprising" instead of "consisting of." Ex parte Dotter, 12 USPQ 382 (Bd. App. 1931). Another acceptable form is recited as "wherein R is A, B, C or D." See MPEP 2173.05(h). The claims improperly recite the Markush group in the form "wherein [R] includes one of [A, B, and C]."

11. Claims 40 and 41 are indefinite because claim 40 recites the phrase "the surface treated UHMW polyolefin particles" at the end of the claim without providing any additional limitations. It is not clear whether the claims were intended to further define the surface treated UHMW polyolefin particles.

12. The phrase "non-destructive separation" in claim 52 is indefinite. Neither the claim nor the specification provide any standard for determining what qualifies as "non-destructive." Furthermore, it is unclear what qualifies as "substantial" preclusion of such separation.

Conclusion

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher G. Paulraj whose telephone number is (703) 308-1036. The examiner can normally be reached on Monday-Friday, 8am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Thibodeau can be reached on (703) 308-2367. The fax phone

numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-0661.

cgp
November 26, 2002

Paul Thibodeau
Supervisory Patent Examiner
Technology Center 1700